

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte IWAO INAGAKI, SEIJI HAMADA, MASAHIRO OHKAWA,
NAOMI ZENGE, and KAORI NANBA

Appeal 2007-3022
Application 09/651,585
Technology Center 2100

Decided: December 12, 2007

Before JEAN R. HOMERE, JAY P. LUCAS, and
ST. JOHN COURTENAY III, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1-15. We have jurisdiction under 35 U.S.C. § 6(b). We Reverse.

THE INVENTION

Appellants invented a client server system which executes an application utilizing distributed objects (Spec. 1). More particularly, Appellants' invention is directed to shortening the response time when an object creation is requested from a client for the first time after start-up of the server. Further, it is another object to increase the utility of the object pool by synchronizing an application and the object pool (Spec. 3).

Independent claim 1 is illustrative:

1. A client server system using distributed objects, comprising:
 - a client connected to a communication network for performing an access request to an object;
 - an application server for performing an application by an actual object according to the access request by said client; and
 - an object pool server connected to said client through said communication network and connected to said application server for pooling a proxy object corresponding to said actual object and for holding actual object management information that is the information on said actual object, wherein said application server notifies said object pool server of an event according to a change in status of said application, and said object pool server automatically updates said actual object management information according to the notification of said event from said application server.

THE REFERENCE

Eytchison

US 6,363,434 B1

Mar. 26, 2002

THE REJECTION

Claims 1-15 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Eytchison.

PRINCIPLES OF LAW

In rejecting claims under 35 U.S.C. § 102, “[a] single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation.” *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1375-76 (Fed. Cir. 2005) (citation omitted). To anticipate, every element and limitation of the claimed invention must be found in a single prior art reference, arranged as in the claim. *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1383 (Fed. Cir. 2001); *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 1576 (Fed. Cir. 1991). “[A]bsence from the reference of any claimed element negates anticipation.” *Kloster Speedsteel AB v. Crucible, Inc.*, 793 F.2d 1565, 1571 (Fed. Cir. 1986).

ANALYSIS

We cannot affirm the Examiner’s anticipation rejection on this record. After carefully reviewing the multiple sections of the Eytchison reference relied upon by the Examiner, we conclude the Examiner, as finder of fact, has not fully developed the record so as to clearly show exactly where the disputed limitations are taught within the reference. To establish a prima facie case of anticipation, the Examiner must show a one-to-one mapping between each element in the claim and the corresponding element found in

the reference. Moreover, every element and limitation of the claimed invention must be expressly or inherently found in the reference, with the corresponding elements in the reference arranged as in the claim. *See Karsten Mfg. Corp.* at 1383.

Here, the Examiner has indicated column numbers and line numbers that purportedly indicate the corresponding elements found in the reference. However, we find the Examiner has mapped multiple claim elements to identical portions of the Eytchison reference without further explanation. For example, in claim 1, the Examiner repeatedly maps the various elements of the claim to one of two cited portions of Eytchison, either column 6, line 64 through column 7, line 11, or column 7, lines 20-29 (*see* Ans. 3). Regarding independent claim 3, the Examiner maps each limitation of claim 3 to the identical portion of Eytchison (column 7, lines 12-28), with no further explanation provided (*see* Ans. 4). The Examiner rejects independent claims 5, 10, and 12 for the same reasons as claim 1 (*Id.*). Similarly, the Examiner rejects independent claims 8, 11, and 13 for the same reasons as claim 3 (*see* Ans. 5). We find the same problem arises with independent claims 14 and 15. The Examiner maps each element of independent claim 14 to the same portion of Eytchison at column 7, lines 12-28 (*see* Ans. 5). Lastly, the Examiner rejects independent claim 15 for the same reasons as independent claim 14 (*Id.*).

We have fully considered the Examiner's response to Appellants' arguments (*see* Ans. 5-10). We find the Examiner's response is primarily

directed to matters of claim construction and does not remedy the aforementioned deficiencies in mapping the elements.

Moreover, we find persuasive Appellants' argument that the electronic devices used in Eytchison are not fairly distributed objects or proxy objects as that term is used in the instant claims (*see* App. Br. 15). While we agree with the Examiner that limitations in the Specification cannot be read into the claims, we nevertheless note that claims are to be given their broadest reasonable construction "in light of the specification as it would be interpreted by one of ordinary skill in the art." *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004).

Here, the instant claims are directed to objects or proxy objects in the context of a distributed object system, as those terms would have been reasonably interpreted by one of ordinary skill in the art at the time of the invention. In particular, we find Appellants' usage of the terms "distributed objects" and "proxy object" comports with the plain meaning of those terms as would have been understood by one of ordinary skill in the art (*see* Spec. 1:14 through 2:6).¹ While Eytchison does disclose various software elements (e.g., "software device proxies," col. 6, l. 41) that may broadly be

¹ "[T]he words of a claim 'are generally given their ordinary and customary meaning.'" *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc) (internal citations omitted). The "ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application." *Id.* at 1313.

considered as “objects,” we nevertheless find no express use of the terms “distributed objects” or “proxy objects” in Eytchison. Thus, while we agree with the Examiner that Eytchison distributes devices and media on a network, we nevertheless find that any purported correspondence to Appellants’ claimed distributed object system is tenuous at best. Therefore, we conclude the Examiner has not applied a reasonable construction to the instant claims in light of the specification as it would have been interpreted by one of ordinary skill in the art at the time of the invention.

Because we agree with Appellants that the Examiner has failed to meet the burden of establishing a prima facie case of anticipation with respect to each claim on appeal, the decision of the Examiner rejecting claims 1-15 is reversed.

CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude Appellants have met their burden of showing that the Examiner erred in rejecting claims 1-15 under 35 U.S.C. § 102(e).

DECISION

We reverse the Examiner’s decision rejecting claims 1-15.

REVERSED

Appeal 2007-3022
Application 09/651,585

clj

DUKE W. YEE
YEE & ASSOCIATES, P.C.
P.O. BOX 802333
DALLAS, TX 75380